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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,842	03/15/2005	Steven Edward Ireland	341305-1010	1890
7590	03/16/2006		EXAMINER	
Thomas Kayden Horstemeyer & Risley Suite 1750 100 Galleria Parkway Atlanta, GA 30339			SMITH, RICHARD A	
			ART UNIT	PAPER NUMBER
			2859	
			DATE MAILED: 03/16/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/527,842	IRELAND, STEVEN EDWARD	
	Examiner R. Alexander Smith	Art Unit 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 2 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received:

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20050627.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 1,008,481 to Lopes in view of US 3,381,654 to Hupp et al.

Lopes discloses a bookmark comprising a thin flat substantially rectangular body having two long sides and two short sides; an indicator(s) comprising a thin, flat collar in frictional contact with the rectangular body (figures 3 and 4); a thin flat rectangular tab (D) formed by two parallel cuts and a lower cut.

Lopes further discloses that the thin flat body and indicators are formed from sheets made of metal and that the tongues of the indicator are bent to hold the rectangular body.

Lopes does not disclose the each of the indicators being formed by cutting or punching blanks, each blank having two, parallel cuts wherein each of the two parallel cuts curve inwardly for a short distance near their ends thus forming bearing surfaces upon which the long edge of the rectangular body impinge, and the tab also having the parallel cuts curved inwardly.

Hupp et al. discloses a bookmark made of a flexible material such as plastic sheet, and discloses for figures 9-12 that the ends 57, 58, 64 and 65 are curved inwardly in semi-circular curved cuts without removal of any material in order to reduce stress concentration of any pulling or bending of the tongues, to provide spacing for trapping the pages, and that no material being removed helps prevent interference with the die cutting processes and that any material can be used including paper and various resinous plastics (column 3 line 52 - column 4 line 18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the bookmark, taught by Lopes, to be made of a flexible plastic or paper material, to incorporate the inward curves, and to cut or punch the bookmark, as taught by Hupp et al., in order to save on costs of material, to eliminate the need to bend the tongues accordingly, to provide a technique to cut or punch the bookmarks without interfering with the cutting process, and to help prevent damage or tearing of the pages of the book.

With respect to the body being rectangular having two long sides and two short sides: This limitation is only considered to be an obvious modification of a body shape because the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of

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numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976). In this case to provide a bookmark that sticks out of the pages so it is noticeable without sticking out too far above the book.

3. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 3,137,269 to Sager in view of US 3,381,654 to Hupp et al.

Sager discloses a bookmark comprising a thin flat substantially rectangular body having two long sides and two short sides and made of a suitable plastic material; an indicator(s) comprising a thin, flat collar in frictional contact with the rectangular body (23); a thin flat rectangular tab (27) formed by two parallel cuts and a lower cut, and that the indicators have two parallel cuts of such a length that the rectangular body may be interlaced with the indicator(s). Furthermore, Sager disclose that the intent is to provide a bookmark which will not mark, scratch, tear or otherwise damage the pages or print thereon.

Sager does not disclose the each of the indicators being formed by cutting or punching blanks, wherein each of the two parallel cuts curve inwardly for a short distance near their ends thus forming bearing surfaces upon which the long edge of the rectangular body impinge, and the tab also having the parallel cuts curved inwardly.

Hupp et al. discloses a bookmark made of a flexible material such as plastic sheet, and discloses for figures 9-12 that the ends 57, 58, 64 and 65 are curved inwardly in semi-circular curved cuts without removal of any material in order to reduce stress concentration of any pulling or bending of the tongues, to provide spacing for trapping the pages, and that no material

being removed helps prevent interference with the die cutting processes and that any material can be used including paper and various resinous plastics (column 3 line 52 - column 4 line 18). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the bookmark, taught by Sager, to incorporate the inward curves, and to cut or punch the bookmark, as taught by Hupp et al., in order to provide a technique to cut or punch the bookmark without interfering with the cutting process, to remove the need for a large space at the tab to accommodate the page while helping prevent damage or tearing of the pages of the book, as taught by Hupp et al.

With respect to the body being rectangular having two long sides and two short sides: This limitation is only considered to be an obvious modification of a body shape because the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976). In this case to provide a bookmark that sticks out of the pages so it is noticeable without sticking out too far above the book, and that can be moved all the way inward to the binder of the book giving more options on placement.

### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related bookmarks.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Alexander Smith whose telephone number is 571-272-2251. The examiner can normally be reached on Monday through Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



R. Alexander Smith  
Primary Examiner  
Technology Center 2800

RAS  
March 14, 2006